

PATENT

Docket No. 56703US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Wayne K. DUNSHEE et al.)

Group Art Unit: 3743

Serial No.: 09/847,941

Examiner: Kim M. Lewis

Confirmation No.: 6157

Filed: 2 May 2001

For: TAPERED STRETCH REMOVABLE ADHESIVE ARTICLES AND METHODS

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RESPONSE

**Commissioner for Patents
Mail Stop Amendment
P.O. Box 1450
Alexandria, VA 22313-1450**

Dear Sir:

The Office Action mailed 26 April 2004 has been received and reviewed.

Reconsideration and withdrawal of the rejections in view of the following comments are respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for notification to the effect that claim 23 is allowable, and that claims 13-18, 52, 55, and 58 would be allowable if rewritten in independent form.

Applicants note that the Examiner indicated that the prior art fails to teach or suggest a method of removing a medical article from the skin comprising “grasping the medical article within the central portion; and stretching the medical article within the central portion to remove the medical article from the skin (Office Action, page 14, paragraph 3). Applicants further point out that independent method claims 50, 53, and 56 comprise such a step. Thus, it is asserted that

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claims 50, 53, and 56, as well as claims 51, 52, 54, 55, 57, and 58 dependent thereto are allowable, and indication to that effect is respectfully requested.

Establishment of Common Ownership

Applicants assert that the present application (U.S. Patent Application Serial No. 09/847,941) and Zhou et al. (U.S. Patent Application No. 2002/0164446 A1) were, at the time the invention of the present application was made, both owned by 3M Innovative Properties Company.

Reservation of Right to Remove Reference

Applicants note that Visintainer (U.S. Patent No. D454,956), which has a filing date of less than two weeks prior to the filing date of the present application, continues to be cited in support of certain rejections presented in this Office Action. Applicants, therefore, maintain reservation of the right to remove Visintainer as a reference by providing an earlier date of invention.

Obviousness-Type Double Patenting Rejection

Claims 1-3, 5-7, 12, 24-27, 37-40, 50-51, 53, 54, 56, 57, and 59-61 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 30, and 51 of copending Application No. 09/934,450 in view of Visintainer (U.S. Patent No. D454, 956).

Claims 4, 8-11, 28-32, and 41-45 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 09/934,450 in view of Visintainer and Curad.

Claims 19-22, 33-36, and 46-49 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 12, 19, and

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28. of copending Application No. 09/847,942 in view of Visintainer (U.S. Patent No. D454, 956).

Upon an indication of otherwise allowable subject matter and in the event these rejections are maintained, Applicants will provide an appropriate response.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 1-3, 5-7, 24-27, 37-40, 50-51, 53-54, 56, 57, and 59-61 under 35 U.S.C. §103(a) as being obvious over Zhou et al. (U.S. Patent Application No. 2002/0164446 A1) in view of Visintainer (U.S. Patent No. D454, 956).

The Examiner rejected claims 4, 8-11, 28-32, and 41-45 under 35 U.S.C. §103(a) as being obvious over Zhou et al. (U.S. Patent Application No. 2002/0164446 A1) in view of Visintainer (U.S. Patent No. D454, 956) as applied to claim 1, and in further view of Curad.

Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Applicants respectfully point out that the present application was filed May 2, 2001, and, as indicated by the Examiner at page 3 of the present Office Action, Zhou et al. constitute prior art only under 35 U.S.C. §102(e). Furthermore, as indicated above, Applicants assert that the present application (U.S. Patent Application Serial No. 09/847,941) and Zhou et al. (U.S. Patent Application No. 2002/0164446 A1) were, at the time the invention of the present application was made, owned by 3M Innovative Properties Company. Thus, Zhou et al. may not be used in a rejection of the present claims under 35 U.S.C. §103 (See also, M.P.E.P. §§ 2146 and 706.02(1)). Applicants further assert that the above statement alone is sufficient evidence to disqualify Zhou

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et al. from being used in a rejection against the claims of the present invention. However, in the event additional evidence is required, Applicants reserve the right to furnish such evidence at a later date.

In view of the above, Applicants assert that upon removal of Zhou et al., the above obviousness rejections cannot be maintained. Thus, Applicants respectfully request that the rejection of claims 1-3, 5-7, 24-27, 37-40, 50-51, 53-54, 56, 57, and 59-61 under 35 U.S.C. §103(a) as being unpatentable over Zhou et al. in view of Visintainer and the rejection of claims 4, 8-11, 28-32, and 41-45 under 35 U.S.C. §103(a) as being unpatentable over Zhou et al. in view of Visintainer as applied to claim 1, and in further view of Curad be reconsidered and withdrawn.

Summary

It is respectfully submitted that the pending claims 1-61 are in condition for allowance and notification to that effect is respectfully requested.

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The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Wayne K. DUNSHEE et al.

By

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26 July 2004
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26th day of July 2004, at 4:25 PM (Central Time).

By: Name: KEVIN W. RAASCH